

## REMARKS

This Amendment is submitted simultaneously with filing of a Request for Continuing Examination.

With the present Amendment applicants amended claims 1, 9 and 14 and added new claims 17-19.

Claim 1 defines that the eccentric element (12a – 12e) is rotatably and fixedly mounted on the armature shaft (14a – 14e). This feature is disclosed in Figure 2 and on page, lines 10-11 and also in lines 15-18 of the specification.

Claims 9 and 14 additionally define that the additional functional unit is the armature shaft (14e) of an electric motor (36e). These features are disclosed in figures 2-7 and on page 5, line 13-15 of the specification.

The features of claim 17 are disclosed in figure 2 and on page 5, lines 7-11 of the specification. The features of claim 18 are disclosed in figure 2 and on page 5, lines 7-11 of the specification. The features of claim 19 are disclosed in figures 3-7 and on page 6, lines 7-10 of the specification.

Turning now to the Examiner's rejection of the claims over the art and in particular to the patent to Pfanzer, it is respectfully submitted that this

reference does not disclose the new features of the present invention as defined in claim 1. The patent to Pfanzler discloses a motor driven jig saw with a housing (1), a motor (2) and an armature shaft (3). Moreover, the jig saw has an eccentric transmission comprising a balancing weight (12) mounted on an eccentric pin (13 of the gear wheel (8), wherein the latter is mounted via an axis (9) and a support member (7), respectively, to the housing (1) of the jig saw (see Pfanzler, figure 1 and column 3, lines 34 to 57).

In contrast, the present application discloses an eccentric transmission, comprising: an imbalance compensation element (10a – 10e); a eccentric element (12a – 12e); an armature shaft (14a – 14e); and a drive shaft (16a – 16e), wherein the eccentric element (12a – 12e) is rotatably and fixedly mounted on the armature shaft (14a – 14e) and rotates with the armature shaft (14a – 14e) and converts, due to its own rotation during an operation mode, a revolving rotary motion of the armature shaft (14a – 14e) into an oscillating rotary motion of the drive shaft (16a – 16e) in order to drive an insertion tool (40a – 40e) of a hand-held power tool (18a – 18e) to oscillate, wherein the imbalance compensation element (10a – 10e) is integral to another functional unit (12a – 12d, 14e). Due to the firm mounting of the eccentric element (12a – 12e) on the armature shaft (14a – 14e) not only a compact design and transmission, which allows an advantageous cost, weight, piece and construction saving device, could be achieved, but also the rotation of the armature shaft (14a – 14e) could be mediated robustly.

The patent to Pfanzer does not disclose that the gear wheel (8) is rotatably and fixedly mounted on the armature shaft (3). Rather, the gear wheel (8) is mounted via an axis (9) and a support member (7), respectively, to the housing (1) of the jig saw (see Pfanzer, figure 1 and column 3, lines 42 to 48). Claim 1, as amended, can be considered as being new in respect of the Pfanzer patent.

Also no motivation is given to mount the gear wheel (8) on the armature shaft (3). The Pfanzer patent teaches to mount the gear wheel (8) on a shaft (9) which is connected via the support member (7) to the housing (1). This is a sophisticated embodiment to arrange the components of the transmission (4, 8, 13, 14, 15, 20) and to mount the gear wheel (8) and thus a transmission for a pendulum movement of a saw blade (20) as well as a mechanism to move a support roller (29) in a space saving manner (see Pfanzer, figure 1 and column 3, line 42 to column 4, line 40). There is no hint provided, which would have led someone skilled in the art at the time the invention was made to the idea to mount the gear wheel (8), the eccentric element, on the armature shaft (3).

Moreover, no one skilled in the art would even consider mounting the gear wheel (8) on the armature shaft (3), because by mounting the gear wheel (8) on the armature shaft (3) the whole power flow from the electric motor (2) to the saw blade (20) would be mediated and supported only via one component of the transmission, specifically, the armature shaft (3), which would

be a disadvantageous load for the armature shaft (3). In addition, this would be against the teaching of the Pfanzer patent, which particularly discloses a supporting member (7), which not only supports the gear wheel (8), but as well the armature shaft (3) itself (see Pfanzer, figure 1 and column 3, lines 42 to 48).

The Examiner rejected the original claims over the Pfanzer patent as being anticipated. In connection with this, it is believed to be advisable to cite the decision *In Re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”

Definitely, the patent to Pfanzer does not disclose each and every element of present invention as defined in amended claim 1 and therefore the anticipation rejection should be considered as no longer tenable and should be withdrawn.

The present invention as defined in claim 1 also cannot be considered as obvious from the Pfanzer patent. In order to arrive at applicant's invention from the reference, the reference has to be significantly modified including into it the features which were first proposed by the applicant. However, it is known that in order to arrive at a claimed invention, by modifying

the references the cited art must itself contain a suggestion for such modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision In Randol and Redford (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

In view of the above present remarks and amendments, it is believed that claim should be considered as patentably distinguishing over the and should be allowed.

As for claim 14, it is respectfully submitted that the patent to Pfanzer also does not teach the features of this claim.

The patent to Pfanzer discloses a motor driven jig saw with a housing (1), a motor (2) and an armature shaft (3). Moreover, the jig saw has eccentric transmission comprising a balance weight (12) mounted on an eccentric pin (13) of a gear wheel (8) (see Pfanzer, figure 1 and column 3, line 34 to 57).

Contrary to the Pfanzer patent, claim 14 of the present application defines an eccentric transmission, comprising: an imbalance compensation element (10a – 10e); an eccentric element (12a – 12e); an armature shaft (14a – 14e); wherein the imbalance compensation element (10a – 10e) is integral to another functional unit (12a – 12d, 14e), and wherein the additional functional unit is the armature shaft (14e) of an electric motor (36e). By integrating the imbalance compensation element (10a – 10e) into the armature shaft (14e) a cost, weight and component saving device could be provided, which could be advantageously used by an operator.

The Pfanzer patent does not disclose that the balancing weight (12) is integral to the armature shaft (3) of the electric motor (2). Rather, it discloses to construct the balancing weight (12) integrally with the eccentric element, namely the gear wheel (8).

In addition, no encouragement is given, which would have motivated a person skilled in the art to construct the balancing weight (12) integrally with the armature shaft (3).

Therefore, it is believed that claim 14 cannot be considered as being anticipated or as being obvious over the patent to Pfanzer.

As for the dependent claims, these claims depend on corresponding independent claims, they share their allowable features and therefore they should be allowed as well.

Reconsideration and allowance of the present application most respectfully requested.

Should the Examiner require or consider it advisable that specification, claims and/or drawings be further amended or corrected in form respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing the case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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